

THE OFFICE ACTION

In the Office Action mailed July 31, 2006, the Examiner withdrew the finality of the previous Office Action since the present application is eligible for continued examination under 37 CFR 1.114, and the fee has been timely paid.

Further, the Examiner stated that all rejections have been overcome after considering Applicant's amendment and accompanying remarks. However, the Examiner notes that, after an updated search, additional prior art has been found.

The Examiner stated that the declaration filed under CFR 1.132 filed May 3, 2006 is insufficient to overcome the rejection of claims 1-17 as set forth in the last Office Action.

Claim 6 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2, 3, 10, 11 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,783,354 issued to Fagan in view of GB 1,541,311 (GB '311).

Claims 4-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fagan and GB '311 as applied to claim 1, and further in view of U.S. Patent No. 5,874,371 issued to Owen.

Claims 12-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fagan in view of GB '311 and U.S. Patent Application No. 2002/0094404 filed by Schottenfeld (Schottenfeld '404).

REMARKS

Examiner's Response to Amendment

The Examiner contends in the current Office Action mailed July 31, 2006 that the Applicant's declaration filed May 3, 2006 is insufficient to overcome the rejection of claims 1-17 as set forth in the previous Office Action mailed March 22, 2006. The Examiner asserts that there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. The Examiner additionally asserts that there is no evidence that, if persons skilled in the art were presumably working on the problem knew of the teachings of the cited references, they would still be unable to

solve the problem. The Examiner further makes note of the ruling that gross sales do not show commercial success absent evidence as to market share based on *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985) or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988). Finally, the Examiner notes that Applicant discusses that “no extensive advertising was conducted” on the liners of the present invention, and the Examiner is unclear what is meant by “extensive.” Applicant responds herein to each of these assertions individually.

First, regarding the assertion that there is no showing that others of ordinary skill in the art were working on the problem or for how long. Applicant respectfully traverses the Examiner’s opinion in this regard for the following reasons. The present application, paragraph [0002], discusses some of the problems of present cover or liner products that do not include an adhesive backing or non slip bottom. For one, “the cover or liner shifts and lifts from the surface of the article to be covered while items stored on the shelf are positioned or removed therefrom. Cover or liner products that include a pressure sensitive adhesive are difficult to position correctly on the shelf and are difficult to remove. The adhesive discourages removal of the cover liner when replacement is desired, or upon removal, a portion of the adhesive is left on the surface of the shelf. Additionally, present adhesive backed shelf coverings that are labeled removable may lose their removable characteristics after repeated applications and gather dirt and lint on their adhesive surfaces.” Further the present application recites that a clear polypropylene protective layer is adhered to the top surface of the film prior to embossing and protects the surface finish which is applied to the top of the film prior to affixing the polypropylene layer (paragraph [0015]).

Applicant respectfully notes that the Information Disclosure Statement mailed April 29, 2004 lists 25 patents and 2 patent applications, at least some of which show that others of ordinary skill in the art were working on the above-listed problems recited in the present application. For example, U.S. Patent No. 5,707,903 issued to Schottenfeld, and filed January 21, 1997 states that, frequently, “the shelf paper is decorated on one side with a solid color or a design, and an adhesive is applied to the other side of the paper so that the paper may be adhered to the surface it covers.

Although the shelf paper usually improves the appearance of the surface to which it is applied, it sometimes leaves a permanent residue or a mark on the surface when it is removed because of the adhesives used and their interaction with the surface and the surrounding environment. For instance, sunlight or grease may chemically change the adhesive and cause a mark. Further, because the shelf paper is made from thin sheet material, it offers very limited protection for preventing damage to the surface to which it is applied. Thus, sharp objects may penetrate the paper and scratch the surface. In addition, falling objects may dent the surface because the thin sheet material used in making the shelf paper does not provide significant cushion" (col. 1, lines 17-33).

Accordingly, at least the above-described problems have been known and worked on by persons of skill in the art from at least January 21, 1997 as shown by the Information Disclosure Statement of record.

Second, regarding the assertion that there is no evidence that if persons skilled in the art were presumably working on the problem knew of the teachings of the cited references, they would still be unable to solve the problem. The above-identified Schottenfeld '903 patent clearly demonstrates that persons skilled in the art were working on the described problems. Further, the Examiner's failure to find any single reference which teaches the embodiments recited and claimed in the present Application offers evidence that persons skilled in the art have been unable to solve the described problems. Further, Applicant's declaration indicates in paragraphs 7 and 8 that, prior to about 2002, coverings or liners including either a non-slip bottom surface or an adhesive bottom surface, and covered by a removable covering, a vinyl film having a color finish resembling a metal adhered to the vinyl film, and a clear polypropylene protective layer adhered to the vinyl film were not known in the United States.

Third, regarding the ruling that gross sales do not show commercial success. Applicant respectfully traverses the Examiner's application of this ruling to Applicant's declaration. In *Cable Electric Products, Inc. v. Genmark, Inc.*, on page 888 of the above-identified USPQ, it is noted that the declaration of chief financial officer, George Lema (Lema declaration) was fairly minimal as to what it showed in relation to commercial success. It is further noted that it would be improper to infer that the reported sales represent a substantial share of any definable market and that this type

of information might bolster the existence in fact of any commercial success. The ruling only applies to affidavits that do not fulfill the requirement that the reported sales represent a substantial share of any definable market. Applicant's declaration satisfies this requirement by defining a market on the basis of market share related to similar products of Henkel Consumer Adhesives (Henkel). In particular, paragraph 5 of Applicant's declaration shows gross shipments of similar earlier products for the years 1996-2005. Paragraph 10 then shows gross shipments of embodiments of the present application for comparison, and the defined market is readily ascertained to be the overall shelf and drawer lining products market of Henkel. The ruling for *Cable Electric Products, Inc. v. Genmark, Inc.* only requires some "definable market" and Applicant's declaration satisfies that requirement.

Further, regarding the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988), Applicant's declaration clearly defines time periods during which the embodiments of the present application and earlier-type products were sold as discussed above with reference to paragraphs 5 and 10 of Applicant's declaration. The sales of earlier-type products are shown in paragraph 5, providing a basis for evaluating the success of the new product as shown in paragraph 10.

Fourth, regarding the Examiner being unclear on what is meant by "extensive." The first sentence of paragraph 11 of Applicant's declaration makes the statement that "No extensive advertising was conducted on the simulated metal shelf coverings and liners." The remainder of paragraph 11 is clearly intended to define what is meant by "no extensive advertising." In particular, the "products were described in Henkel's catalog, on Henkel's website, and at professional meetings. The products were described in point of sale materials and, possibly, in retailer advertisements. Henkel did not place print, television or other consumer directed advertising for these products." Applicant respectfully submits that this is the intended meaning, as provided in the declaration, for the phrase "no extensive advertising."

For the above-stated reasons, Applicant respectfully requests that the Examiner reconsider the declaration under 37 CFR 1.132 filed May 3, 2006.

§112 Rejection

Dependent claim 6 has been amended to recite the phrase "said substrate" in place of "said scrim." Claim 6, as amended, should now be in compliance with 35 U.S.C. §112, second paragraph,

Claims 1-11 and 17 are Patentable over Fagan in View of GB '311

With reference to the rejection of claims 1, 2, 3, 10, 11 and 17, the Examiner argues that the subject claims are unpatentable over Fagan in view of GB '311. Applicant respectfully traverses the Examiner's rejection of the subject claims for the following reasons. Independent claim 1 of the present application, as amended, clearly recites that the substrate has a bottom surface which comprises a non-slip, non-adhesive surface. On the other hand, Fagan clearly teaches the use of a pressure sensitive adhesive to the inner surface of a base sheet (col. 3, lines 31-34). Independent claim 1 of Fagan also recites a limitation for the pressure sensitive adhesive. Fagan neither teaches nor suggests the use of a non-adhesive sheet material. Further, GB '311 specifically pertains to pressure sensitive adhesive coated laminates (page 1, lines 12-15). The Examiner has not shown where either Fagan or GB '311 teach or suggest the use of a non-adhesive sheet material or covering as recited in claim 1, as amended, of the present application.

For the above-described reasons, Applicant submits that independent claims 1 and 17 are patentably distinct over the references and, therefore, are in condition for allowance, as are claims 2-11 depending from claim 1.

Claims 12-16 are Patentable over Patentable over Fagan in View of GB '311 and Schottenfeld '404

With reference to claim 12, the Examiner has combined 3 references in rejecting independent claim 12. Applicant respectfully submits that it would not be obvious to one in the art to combine the 3 references for the reasons set forth in the discussion above relating to Applicant's declaration. Problems solved by the claimed embodiment of the present application have been known since at least January 21, 1997, and probably earlier, but no one of skill in the art prior to the present application has suggested a solution to the above-listed problems. The Examiner has simply, after the fact, combined references based solely on finding a combination which includes the

limitations recited in claim 12. Applicant submits, therefore, that this combination was not obvious prior to the filing of the present application.

For the above-described reasons, Applicant submits that independent claim 12 is patentably distinct over the references and, therefore, in condition for allowance, as are claims 13-16 depending therefrom.

For the above reasons, Applicant requests withdrawal of the § 103(a) rejections.

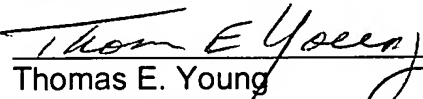
CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-17) are now in condition for allowance. Should the Examiner need more information or wish to discuss the present application, Applicant would appreciate the opportunity to assist in moving the case forward to a successful conclusion. In this regard, Thomas Young may be contacted at 216-861-5582.

Respectfully submitted,

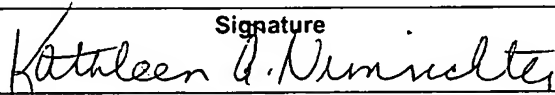
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October 30, 2006
Date


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CERTIFICATE OF MAILING

Under 37 C.F.R. § 1.8, I certify that this Amendment is being deposited with the United States Postal Service as First Class mail, addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

	Signature 
Date: October 30, 2006	Printed Name: Kathleen A. Nimrichter

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